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REMARKS

Claims 1-3, 5-20 and 24-26 are currently pending in this application.

Reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. § 1.116, in light of the remarks which follow, is respectfully requested.

Claims 1-3, 5-20 and 24-26 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,291,011 ("Edlund") in view of U.S. Patent No. 4,902,722 ("Melber"). Claims 1-3, 5-20 and 24-26 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Edlund in view of U.S. Patent No. 4,433,022 ("Schwartz"). Withdrawal of these rejections is requested in view of the following remarks.

The process of the present invention produces a decorative wallcovering having a first hydrophobic layer applied to selective portions of the impregnated fabric in the form of a decorative pattern and a second layer applied to selective portions of the fabric in the form of a foamed three-dimensional image pattern. The product is designed to be applied to a wall and may subsequently be painted to create colorful three-dimensional designs of an infinite variety.

The process of Edlund involves the initial application of a hydrophilic layer over the entire surface of a glass fiber fabric followed by the application of a hydrophobic layer in a decorative pattern on selected portions of the hydrophilic layer. After application to a wall surface, the conditioned, partially decorated wallcovering is painted. Since the surface of the wallcovering has discontinuous hydrophobic and hydrophilic areas, the finished painted product exhibits distinctive decorative images as exemplified in Figure 3 of Edlund.

Accordingly, it is an important feature of Edlund that the process described therein produces a "conditioned" intermediate product having a significant area with hydrophilic properties as well as patterned hydrophobic areas. When subsequently painted, the resultant product is a

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finished wallcovering with distinctive contrasting patterns as a result of applying the paint to hydrophilic and hydrophobic areas.

Edlund does not disclose the presently claimed step of providing a three-dimensional decorative foamed pattern by heating a mixture of expandable chemicals. The Examiner alleges that it would have been obvious to so modify the process of Edlund in view of Melber or Schwartz. Respectfully, Applicants disagree.

Melber and Schwartz both disclose the application of an expandable coating to a fibrous substrate followed by heating to produce a three-dimensional foamed decorative layer on the substrate. Neither reference discloses applying the expandable coating to an already-decorated substrate.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The motivation to modify the relied on prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Napier*, 55 F.2d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995). Obviousness cannot be established by modifying the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the modification. *In re Geiger*, 815 F.2d 686, 688, USPQ2d 1276, 1278 (Fed. Cir. 1987).

The teachings of Melber and Schwartz may establish that expandable coatings to provide three-dimensional decorative effects were known in the art. They provide no

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suggestion, however, to add a step of using an expandable coating to the process of Edlund.

As stated in *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000),

Most if not all inventions arise from a combination of old elements. . . . Thus, every element of a claimed invention may often be found in the prior art. . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. . . . Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [Citations Omitted].

In the Office Action mailed June 22, 2006, the Examiner asserts, "Even though the material of Edlund is intended to be painted, this would not preclude one of ordinary skill in the art from providing the foamable coating in order to impart additional design to the material." (Paragraph 5, Page 4). The issue is not whether one skilled in art would be precluded from adding a foamable coating but, rather, whether the cited art in combination contains a suggestion to do so.

More specifically, Edlund is directed to a feasible and economic process to produce an intermediate rolled good product, which when applied to a wall and painted by a consumer, will display a distinct and decorative image effect. (Column 2, Lines 9-13). Accordingly, Edlund provides a glass yarn fabric product suitable for subsequent application to walls or structures, which fabric is coated and conditioned such that later application of paint results in a desired and selective image effect. (Column 2, Lines 17-21). The product of Edlund possesses the same benefits and favorable properties as untreated standard glass fiber wallcovering, with the added benefit of producing paint effects in a user selected color. (Column 4, Lines 29-33). The Examiner acknowledges that "Edlund does not teach applying a second image coating of expandable material." (See Office Action mailed June 22, 2006, Paragraph 3, Page 2, and Paragraph 4, Page 3).

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The Examiner asserts that one of ordinary skill in the art would have been motivated to modify Edlund in view of Melber or Schwartz in an attempt to achieve the presently claimed process. In particular, the final Office Action asserts, "[A] person of ordinary skill in the art would have been motivated to apply the coating of Melber or Schwartz to the substrate of Edlund with the expectation that this would *further enhance* the decorative appearance of the wallcovering of Edlund." (Emphasis Added; Paragraph 4, Page 3).

However, the Examiner has failed to identify where in the prior art one of ordinary skill would have found a disclosure or suggestion which would have led him to make the proposed modification. *See Kotzab*, 27 F.3d at 1371, 55 USPQ2d at 1317. In this regard, Applicants note that the application of paint to the glass yarn fabric product of Edlund results in *desired and selective* image paint effects in a *user selected* color. The absence of particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed, in support of the rejection of claims 1-3, 5-20, and 24-26, renders the rejection improper.

An adequate showing of motivation to combine requires evidence that a person of ordinary skill in the art would, confronted with the same problems as the inventor and with no knowledge of the presently claimed process, would select the elements from the cited prior art references for combination in the manner claimed. *Ecolochem Inc. v Southern Calif. Edison Co.*, 227 F.3dd 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000), quoting *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).

In the present case, the Examiner has not shown that the skilled artisan confronted with obtaining wall coverings with distinct image effects with three-dimensional finish structures, would have selected the features from Melber or Schwartz and combined them with Edlund absent knowledge of the presently claimed process. Specifically, as noted

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above, Edlund already provides a product that when applied to a wall and painted by a consumer displays a distinct and decorative image effect. Because the only reason or suggestion to modify Edlund comes from Applicants' disclosure, the rejection is improper and should be withdrawn.

According to the Examiner, it would have been obvious to use the image coating step of Melber or Schwartz in the process of Edlund. However, applying the expandable coating of Melber or Schwartz to the partially decorated, "conditioned" wallcovering of Edlund would cover the hydrophilic areas which would be unavailable for subsequent painting and would be contrary to the objectives of Edlund.

Applicants submit that there is no disclosure in the cited art which would have motivated those of ordinary skill in the art to modify the process of Edlund to include the step of Melber or Schwartz. Nor could one have reasonably expected that such a modification would have been successful, bearing in mind that applying an expandable coating to the partially imaged fabric of Edlund would undoubtedly cover the hydrophilic areas which are designed to be painted by the consumer to effect a final decorative effect.

The final Office Action additionally contends,

Edlund intends to create a substrate to which *decorative material* can be applied. Melber and Schwartz each teaches a *decorative material* which can comprise dyes and pigments and which can be applied to substrates in order to decorate them. Therefore, to apply the *decorative coating* of Melber or Schwartz to parts of the substrate of Edlund would not be contrary to the invention of Edlund

(Emphasis Added; Paragraph 5, Page 3).

As noted above, the Examiner has asserted that "the material of Edlund is intended to be painted". (Office Action mailed June 22, 2006, Paragraph 5, Page 4). As described in the specification of Edlund, FIG. 3 depicts examples of the finished image produced following painting of the treated glass fiber wallcovering. (Column 4, Lines 25-27).

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As explained in MPEP § 2143.01, Section VI., if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicants further respectfully submit that since the proposed application of the *syntactic foam material* of Melber or the *expandable or foamable coating* of Schwartz to parts of the substrate of Edlund would change the principle of operation of Edlund (*i.e.*, *painting* of a hydrophobic image coating of a glass yarn fabric product to produce a desired and selective image effect), the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The final Office Action also similarly contends, "[T]he motivation to make the combination would come from the fact that Edlund teaches a substrate onto which *decorative coatings* can be applied and Melber and Schwartz teach particular *decorative coatings* which can be applied to substrates in order to impart a textured, aesthetically appealing decoration onto the substrate." (Paragraph 6, Page 4).

Again, the Examiner has asserted that "the material of Edlund is intended to be painted". (Office Action mailed June 22, 2006, Paragraph 5, Page 4). Applicants respectfully submit that the proposed combination of Edlund with Melber or Schwartz would change the principle of operation of Edlund. As also noted above, Edlund provides a product that when applied to a wall and painted by a consumer displays a distinct and decorative image effect. Thus, the proposed combination of Edlund with Melber or Schwartz is unnecessary to "to impart a textured, aesthetically appealing decoration onto the substrate [of Edlund]."

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Claims 1 and 24 specify that the second image coating is "applied from a chemical mixture consisting essentially of a polymeric binder and expandable chemicals" (claim 1) or "consisting essentially of a polymeric binder and expandable microspheres" (claim 24). The expandable compositions disclosed in Melber are set forth in Examples II, III and IV. These contain expandable microspheres, pre-expanded microspheres, water and an unspecified vehicle. No polymeric binders are present in these expandable formulations, let alone in the amount set forth in present claim 25.

For at least the aforementioned reasons, the §103(a) rejection based on Edlund in view of Melber or Schwartz should be withdrawn. Such action is earnestly requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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